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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,154	10/11/2005	Hiromu Ueshima	04995/24001	9213

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EXAMINER

BIAGINI, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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2442

NOTIFICATION DATE	DELIVERY MODE
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04/23/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/552,154	Applicant(s) UESHIMA ET AL.	
	Examiner Christopher Biagini	Art Unit 2442	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20, 21, 23, 26, 27 and 29-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 20, 21, 23 and 30-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26, 27, 29, and 42-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

This application has been assigned to a new examiner. Contact information is located at the end of this action.

Election/Restrictions

Applicant's election without traverse of claims 26, 27, 29, and 42-48 in the reply filed on February 24, 2009 is acknowledged. Claims 1-18, 20, 21, 23, and 30-41 are withdrawn as being directed to a nonelected invention(s).

Response to Arguments

Applicant's arguments with respect to the rejection(s) of claim(s) 26, 27, 29, and 42-48 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: although there is ample support for *recording* media in the specification, the specification does not provide antecedent basis for the term "computer-readable medium" as used in claims 46-48.

Claim Objections

Claim 27 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends or, in other words, that it shall not conceivably be infringed by anything which would not also infringe the basic claim. See MPEP 608.01(n). In this case, claim 29 requires a "first proprietary connector" and a "second proprietary connector." A plain reading of the claim would indicate that the first and second connectors are distinct from one another. Dependent claim 27, however, recites that the "first proprietary connector serves also as said second proprietary connector." In other words, claim 27 removes the limitation which makes the connectors distinct. Thus, a system with a single connector would infringe claim 27, but not claim 29. Therefore, claim 27 is not a proper dependent claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 46-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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The claims recite “a computer-readable medium encoded with a computer program.” Giving this limitation its broadest reasonable interpretation, the claims encompass embodiments where the computer-readable medium is a carrier wave or other propagation medium. Propagation media are not capable of being functionally and structurally related to the programs they contain, and thus the claims are not directed to any of the statutory categories of invention defined in 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 26, 27, 29, and 42-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “proprietary” in claims 29 and 42-48 is apparently used by the claim to mean “not compatible with pre-existing commercial systems”, while the accepted meaning is “made and sold by one with the sole right to do so.” The term is indefinite because the specification does not clearly redefine the term.

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Furthermore, both meanings—"not compatible with pre-existing systems" and "made and sold by one with the sole right to do so"—raise serious questions as to the metes and bounds of the claims. For example, with regard to the first meaning and using paragraph [0174] of the instant specification as a guide, it is unclear to what extent an existing system must be modified before it becomes proprietary. It is also unclear whether a particular authority must certify the original as "standard," or whether the "standard" requires a certain degree of commercial success to become "mass-marketed." With regard to the second meaning, it is not clear if a system becomes proprietary only upon granting of patent, trademark, or other exclusive rights. Furthermore, it is unclear whether the system would cease to become proprietary if it were licensed to more than one manufacturer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27, 29, and 42-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (US Pub. No. 2003/0041123) in view of Braitberg (US Pub. No. 2001/0006503).

Regarding claim 29, Sato shows a content delivery system comprising:

- a memory device (comprising an optical disc or semiconductor memory: see [0033] and [0157];

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- a content server (server 20) connected to a network and providing a content delivery service on the network (see [0032]); and
- a writer (user terminal 30) having a facility for receiving content from said content server through the network and configured to write the content to said memory device (see [0037]),
- wherein said writer writes the content only once in a writable storage area of said memory device where data has not been written (inherent to the operation of a CD-R disc: see [0033]), only when said memory device is appropriate for said content delivery system (comprising only when the device is determined to be legitimate: see [0047]).

Sato does not explicitly show:

- that the memory device is a memory cartridge having a proprietary interface for accessing data contained therein;
- a content using system which is distributed to a user of said content and provided with a first proprietary connector compatible with and connectable to said proprietary interface of said memory cartridge for reading content therefrom and using the content;
- that the writer is provided with a second proprietary connector compatible with and connectable to said proprietary interface.

Braitberg shows:

- a memory cartridge (storage cartridge 112 containing a write-once recording device: see Fig. 1, [0052], and [0060]) having a proprietary interface for accessing data

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- contained therein (note that Braitberg introduces an enveloping cartridge which was not present in existing media: see [0019]-[0021]);
- a content using system which is distributed to a user of content and provided with a first proprietary connector compatible with and connectable to said proprietary interface of said memory cartridge for reading content therefrom and using the content (comprising, for example, a portable music player which has a drive containing the necessary mechanisms for reading data from the memory cartridge: see [0077]-[0080] and [0107]-[0108]);
 - a writer provided with a second proprietary connector compatible with and connectable to said proprietary interface (comprising a drive containing the necessary mechanisms for writing data on the memory cartridge: see [0077]-[0080]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Sato to use a proprietary cartridge as taught by Braitberg in order to provide a durable, compact recording medium that avoids both physical damage and accidental erasure (see Braitberg, [0023]-[0024] and [0110]).

Regarding 27, the combination further shows wherein said writer unit is implemented within said content using system, and said first proprietary connector serves also as said second proprietary connector. See Braitberg, [0080], and note that the drive is capable of both writing data (i.e., as a writer unit) and reading data (i.e., using content as a content using system).

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Claims 42-48 correspond to claim 29 and are rejected for the same reasons as given above.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (US Pub. No. 2003/0041123) in view of Braitberg (US Pub. No. 2001/0006503), and further in view of Kato (US Patent No. 5,886,275).

The combination shows the limitations of claim 29 as applied above, but does not show wherein said content is karaoke data, and said content using system is a karaoke playback system which plays back the karaoke data.

Kato shows karaoke data and a karaoke playback system which plays back the karaoke data (see col. 1, lines 10-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system of Sato to include karoke data and playback as taught by Kato in order to allow users of the system to showcase their singing talents for friends and family.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Biagini whose telephone number is (571) 272-9743. The examiner can normally be reached on weekdays from 8:30 AM to 5:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Caldwell/
Supervisory Patent Examiner, Art Unit
2442

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